



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,548	08/20/2003	Vivien Chan	59516-159/PP-01602.006	7950
27476	7590	08/09/2006	EXAMINER	
Chiron Corporation Intellectual Property - R440 P.O. Box 8097 Emeryville, CA 94662-8097				O'HARA, EILEEN B
		ART UNIT		PAPER NUMBER
		1646		

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/644,548	CHAN ET AL.	
	Examiner Eileen B. O'Hara	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 18-20 and 24-27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 12, 13, 15-17, 22 and 23 is/are rejected.
- 7) Claim(s) 14 and 21 is/are objected to.
- 8) Claim(s) 1-27 <sup>were</sup> are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 August 2003 and 12 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

1. Claims 1-27 are pending in the instant application.

***Election/Restrictions***

2. Applicant's election of Group II, polypeptides, and SEQ ID NO: 2 in the reply filed on May 24, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-11, 18-20 and 24-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 12-17 and 21-23 are currently under examination.

***Priority***

3. Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), the first sentence of the specification or application data sheet (37 CFR 1.76) should include a reference to the prior application(s) from which benefit of priority is claimed, and also the status. See 37 CFR 1.78. The status of application 09/641,612 should be updated (now U.S. Patent No. 6,703,221).

***Claim Objections***

4. Claims 12-14 and 21-23 are objected to because of the following informalities: they encompass a non-elected invention, the polypeptide of SEQ ID NO: 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.1 Claims 12, 13, 15-17 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides having at least 95% sequence identity with the protein of SEQ ID NO: 2, or polypeptide of SEQ ID NO: 2 comprising at least one conservative amino acid substitution, or an epitope bearing portion of a polypeptide comprising the amino acid sequence of SEQ ID NO: 2 which comprises about 5 to 50 or 10 to 20 contiguous amino acids, or a complex comprising a fragment of the amino acid sequence of SEQ ID NO: 2. The claims do not require that the polypeptide possess any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. Thus, the claims are drawn to a genus of polypeptides that is defined only by sequence identity.

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of compete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

*Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed.*” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only isolated polypeptides comprising the amino acid sequence set forth in SEQ ID NO: 182, but not the full breadth of the claim meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

5.2 Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 encompasses a pharmaceutical composition comprising the polypeptide of SEQ ID NO: 2. Thus the claims encompass a “pharmaceutical use” for the compositions. For the claims to be enabled, the specification must teach how to use the composition for at least one pharmaceutical use without undue experimentation. Steadman’s Medical Dictionary (24<sup>th</sup> Edition, 1982) defines “drug” as “a therapeutic agent; any substance other than food, used in the prevention, diagnosis, alleviation, treatment or cure of disease in man and animal.” Ansel et al (Pharmaceutical Dosage Forms and Drug Delivery Systems, Seventh Edition), says “A drug is defined as an agent intended for use in the diagnosis, mitigation, treatment, cure or prevention of disease in humans or in other animals. One of the most astounding qualities of drugs is the diversity of their actions and effects on the body.” The following are examples of

“pharmaceutical uses”: administering vitamin supplements (preventing disease); using labeled antibodies for in vivo imaging (diagnosing disease); administering a substance to alleviate a symptom of a disease (alleviating or treating disease); and administering an antibiotic (curing bacterial infection). Administering a polypeptide to produce antibodies to protect the individual from contracting a disease, i.e., vaccination, is a pharmaceutical use, however, administering a polypeptide to produce antibodies which are then collected from the animal and used in various ways is not a pharmaceutical use.

In the present situation, to enable a pharmaceutical use for the polypeptide requires the specification to teach how to use the substance, without undue experimentation, for the prevention, diagnosis, alleviation, treatment or cure of a disease in the animal to which the substance is administered. However, the specification does not provide adequate guidance as to how the polypeptide can be used to treat or diagnose any disorders. The specification on page 37, line 12 to page 39, line 26, states that the proteins will have uses including the preparation of pharmaceutical compositions, and give as an example being desirable for promoting angiogenesis. However, there are no examples of treatment by administration of the protein.

Due to the lack of direction or guidance in the specification, the absence of working examples and teachings of the prior art, the unpredictability in the art, and the complex nature of the invention, undue experimentation would be required of the skilled artisan to use a “pharmaceutical composition” comprising polypeptides. However, the specification enables the use of “a composition” comprising the polypeptide of SEQ ID NO: 2 and a pharmaceutically acceptable carrier. Deletion of the word “pharmaceutical” in the claims would therefore obviate the rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 Claim 13 is indefinite because of the term “except for at least one conservative amino acid substitution”, it encompasses a protein in which the majority of amino acid residues could be substituted by a conservative amino acid, which would result in a completely different protein. The resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

7.2 Claims 15-17 are indefinite because claim 15 recites “An epitope-bearing portion of a polypeptide **comprising consisting** of SEQ ID NO: 2”. The phrase “**comprising consisting**” renders the claims indefinite.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunwoodie et al., Development, Vol. 124, pages 3065-3076, 1997.

Claims 15-17 encompass an epitope-bearing portion of a polypeptide comprising or consisting of SEQ ID NO: 2, wherein the epitope-bearing portion comprises about 5 to about 50 or about 10 to about 50 contiguous amino acids.

Dunwoodie et al. disclose the mouse delta-like 3 protein, which is 84% identical to the protein of SEQ ID NO: 2 of the instant invention. The protein of Dunwoodie et al. contains numerous long stretches of amino acids that are identical to those of SEQ ID NO: 2, for example, there is a 48 contiguous amino acid stretch identical to amino acids 360-407 of SEQ ID NO: 2 (see attached alignment). Therefore Dunwoodie et al. anticipates the claims.

***Conclusion***

- 9.1 Claims 14 and 21 are objected to.
- 9.2 Claims 12, 13, 15-17, 22 and 23 are rejected.
- 9.3 The full length sequence of SEQ ID NO: 2 is free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nichol can be reached at (571) 272-0835.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Art Unit: 1646

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner



**EILEEN B. O'HARA**  
PRIMARY EXAMINER